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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,252	08/13/2001	Gerard Wolfe Sormann	64194-9004	8084

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EXAMINER

YU, JEANNE C

ART UNIT PAPER NUMBER

3762

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,252

Applicant(s)

SORMANN ET AL.

Examiner

Jeanne Yu

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 4-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 14-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 10.

Applicant's election with traverse of Group I in Paper No. 10 is acknowledged.

The traversal is on the ground(s) that Groups I and IV are used primarily inside the body. The traversal is also on the ground(s) that Group V cannot be implemented without the transmittal of signals. This is not found persuasive. Group III is directed to an appliance capable of receiving radiation. The appliance can be used in a different system such as a locator. Groups IV and V recite muscle stimulation including an electromyogram recorder. The apparatus and method of elected claims 1-10 and claims 11-13 do not require the particulars of the recorder/sensor. Finally, the apparatus of Group VI can be used to transmit various information signals, not just those to a living body. Furthermore, the claim recites no receipt of the transmittal of signals.

For these reasons, claims 14-25 are withdrawn from consideration. The requirement is therefore made FINAL.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Transmission of high frequency electromagnetic radiation in a medical implant system.

Claim Objections

Claims 4-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the antenna format" in line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

1. Claims 1, 2 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Forsell
USPN 6,210,347.

Forsell discloses a system and a method for transmission of power (c 2, l 63-64) and/or information (c 7, l 5) between a first location external of a living body at which a primary controller 36 (Fig 4) comprising a power source – an inherent component for powering the signal generator 48 – and a transmitter 32 (Fig 4) is located, and a second position internal of the living body at which an antenna based device 34 (Fig 4) is located, the system and method comprising:

generating high frequency electromagnetic radiation between 0.5 to 2.5 Ghz, i.e. from 100 kHz to 1 GHz (c 5, l 50-52), from the signal generator 48 and emitting that radiation from the transmitter 32 of the primary controller 36 (c 7, l 11-10);

receiving the radiation at the antenna based device 34 (c 7, l 11-17);

powering the antenna based device with the radiation (c 7, l 11-17); and

causing the antenna based device 34 to generate and emit pulses of current, i.e. amplitude modulation (c 7, l 22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forsell USPN 6,210,347 in view of Ponapalli et al. USPN 5,583,510.

As discussed in section 1 of this action, Forsell discloses the claimed invention except for an antenna format of the antenna based device being a planar omnidirectional format that is integrated into the construction of the antenna based device. Ponapalli discloses a planar

Art Unit: 3762

omnidirectional antenna (c 2, l 55-60). Forsell and Ponapalli are analogous art because they are from a similar problem solving area of transmitting signals between wireless devices. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the receiving antenna 34 of Forsell by replacing it with the planar omnidirectional antenna of Ponapalli. The motivation for doing so would have been to transmit higher frequency signals, i.e. 2.4 - 2.483 Ghz in the industrial, scientific and medical (ISM) band (Ponapalli c 1, l 41-45). Therefore, it would have been obvious to combine Ponapalli with Forsell to obtain the invention as specified in Claim 3.

Conclusion

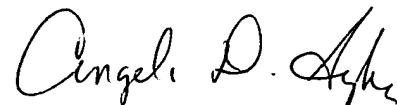
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeanne Yu whose telephone number is 703-305-7569. The examiner can normally be reached on Monday-Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703-308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


JCY

February 6, 2003



ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
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